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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,148	01/26/2001	Gary Douglas Huber	M-9876US	7341

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HAYNES AND BOONE, LLP
901 MAIN STREET, SUITE 3100
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EXAMINER

MARTINEZ, DAVID E

ART UNIT PAPER NUMBER

2182

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/770,148

Applicant(s)

HUBER ET AL.

Examiner

David E. Martinez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE filed on 8/29/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/29/05 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With regards to claim 1, it includes the newly amended limitation "...whereby the PDA system is automatically synchronized...". However, the specification fails to provide an enabling disclosure to support the claimed limitation of having the PDA system be automatically synchronized.

With regards to claim 17, it suffers from the same deficiencies as those of claim 1, and thus is rejected under the same rationale.

Claims 1 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regards to claims 1 and 17, the term "...whereby the PDA system is automatically synchronized..." renders the claim indefinite since it isn't clear what or how an element is exactly being automatically synchronized. Is it the system clocks between the PDA and the PC that are being synchronized? Is it the use of a shared device that is being synchronized as in the PDA using the shared device, and then when it's done, the PC uses the shared device and then the PC gives back control to the PDA?

Due to the vagueness and a lack of clear definiteness in the claims, the claims have been treated on their merits as best understood by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of US Patent No. 6,493,782 to Verdun et al. (Verdun).

1. With regards to claims 1 and 17, AAPA teaches a mobile computing system comprising of:

a personal computer (PC) system [fig 1];

a personal digital assistant (PDA) system [fig 2] that interfaces to the PC system [page 3 lines 13-20];

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a PC chassis housing the PC system [fig 1, element 100, page 2 lines 10-21, page 3, lines 21-24];

a PDA chassis housing the PDA system [fig 2];

the PDA chassis being mounted in the PC chassis [page 3, lines 21-24] whereby the PDA system operates concurrently with the PC system including power, input and display [page 3 lines 13-20];

AAPA teaches all of the above limitations, but is silent as to whereby the PDA system is automatically synchronized, the PDA chassis being removed from the PC chassis at any time including being in an off, on or running mode, whereby the PDA automatically transitions into its own self-contained system to operate independently of the PC system including power, input and display.

However, Verdun teaches a portable computer (PDA chassis) that is automatically synchronized to its expansion unit (PC chassis), the PDA chassis being able to be removed from its PC chassis at any time including being in an off, on or running mode, whereby the PDA automatically transitions into an independent its own self-contained system to operate independently of the PC system including power, input and display [column 2 lines 38-57 and line 66 to column 3 line 5] for the benefit of being able to connect and disconnect the portable computer in all power state configurations.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of AAPA, and Verdun to have the PDA chassis be automatically synchronized, the PDA chassis being able to be removed from the PC chassis at any time including being in an off, on or running mode, whereby the PDA automatically transitions into its own self-contained system to operate independently of the PC system including power, input

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and display for the benefit of being able to connect and disconnect the PDA in all power state configurations.

2. With regards to claim 2, AAPA teaches the mobile computing system of claim 1 wherein the PDA system is further comprised of:

an input device [fig 2, elements 205, 210, page 3 lines 3-12].

3. With regards to claim 3, AAPA teaches the mobile computing system of claim 2 further comprising: an antenna for wireless communications [fig 2, element 215, page 3 lines 3-12].

4. With regards to claims 4, 5, and 6, AAPA teaches wherein the PC chassis further comprises one or more expansion bays [fig 1, elements 110, 115], wherein the PDA chassis is placed in one of the bays [page 2 lines 16-21, page 3, lines 13-22].

5. With regards to claims 7, 8, and 9, AAPA teaches wherein the PDA chassis is placed in the interior of the PC chassis [fig 1, elements 110, 115, page 2 lines 16-21, page 3, lines 13-22].

6. With further regards to claim 17, AAPA teaches a method of integrating a removable PDA system [fig 2] with a PC system [fig 1] comprised of:

connecting the PDA system to the PC system by a separable interface [page 3 lines 3-24];

isolating control to either PDA system or PC system when instructed by a user or a predetermined system logic [page 3, lines 13-22].

Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of US Patent No. 6,493,782 to Verdun et al. (Verdun). as applied to claims 1-3 above, and further in view of US Patent No. 5,768,163 to Smith, II (Smith).

7. With regards to claims 10-15, the combination of AAPA and Verdun fail to teach wherein the PDA chassis is placed on the exterior of the PC chassis, and on the top of the PC chassis.

However, Smith teaches the use of a connector for connecting a PDA with a PC chassis [figs 1-7, 10, column 1 line 40 to column 2 line 34] for the benefit increasing the ease of sharing of information between devices.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of AAPA, Verdun, and Smith to provide the PDA chassis is able to be placed on both the exterior and on top of the PC chassis for the benefit of increasing the ease of sharing of information between devices.

Response to Arguments

Applicant's arguments filed on 8/2/05 with respect to claims 1-15 and 17, have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues the previously mailed Office Action dated 6/2/05 does not disclose the newly added limitations of amended claims 1 and 17 directed to the PDA chassis. The Applicant only argues generic terms and does not argue (doesn't even mention) any details of the references relied upon by the examiner. Applicant only argues the amended claims and does not mention any details directed to the previous office action. The current Office Action discloses the newly added limitations directed to the PDA chassis as shown above in the "Claim Rejection" section.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Martinez whose telephone number is (571) 272-4152. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on (571) 272-4083. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DEM



KIM HUYNH
PRIMARY EXAMINER
9/16/05